

## **REMARKS**

The present amendment is submitted in response to the Office Action mailed March 8, 2005.

Claims 11-16 and 18-20 stand rejected under 35 U.S.C. §102(b) by U.S. Patent No. 4,719,825 to LaHaye et al. LaHaye '825 relates to a metering needle assembly for dispensing tattoo dye or ink.

It is respectfully submitted that the present invention is patentably distinguishable from LaHaye '825 and is therefore allowable thereover. For example, LaHaye '825 fails to teach or suggest the recited "dispensing said ink dispensing instrument after use on the patient" as recited in independent claim 11. In contrast, the needle assembly of LaHaye '825 is not a disposable instrument, but rather includes a complex mechanism for dispensing of the dye. The mechanism and instrument are reusable. In fact, LaHaye '825 specifically teaches away from dispensing or discarding of his device after use on a patient, see, e.g., col. 3, lns. 9-14 of the "825 patent. Thus, the step of "discarding of the instrument after use on the patient" can not be considered inherent as suggested in the Office Action. With regard to independent claim 12, LaHaye '825 fails to teach or suggest the recited "ink cartridge is substantially flexible to permit the operator to manually deform said ink cartridge by direct engagement of said ink cartridge with a hand of the operator to dispense said tattoo ink through said port". The device of LaHaye '825 is devoid of this feature. With regard to independent claim 20, LaHaye '825 fails to teach the recited "flexible ink cartridge". Accordingly, in view of the foregoing, withdrawal of this rejection is respectfully requested.

Claims 11-17 and 20 stand rejected under 35 USC 102(e) by U.S. Patent No. 6,056,737 to Rosen. Rosen '737 discloses a marking device for applying a flourogenically-effective amount of a furanone to the teeth of the user to assist in identifying plaque.

It is respectfully submitted that the present invention is patentability distinguishable from Rosen '737 and is therefore allowable thereover. For example, Rosen '737 fails to teach or suggest the recited "positioning an ink dispensing instrument having sterilized tattoo ink therein adjacent a patient". Rosen '737 is not concerned with marking an individual with tattoo ink, e.g., dye, but rather teaches the use of a furanone to help identify plaque under ultraviolet light. Furanone is not a tattoo ink, e.g., dye. Moreover, Rosen' 737 is not concerned with "mark[ing] the body tissue to generally correspond to a target location for radiation therapy" as recited in independent claim 11. With regard to independent claim 12, Rosen 737 fails to teach or suggest the recited "ink cartridge and sterile tattoo ink disposed within the ink cartridge" as required by claim 12. Rosen 737 is not concerned with tattoo ink, e.g., dye, but rather is directed to applying furanone to the teeth of a patient for ultraviolet detection. Furanone is not a tattoo ink or dye. With regard to independent claim 20, Rosen 737 fails to teach or suggest "sterile tattoo ink disposed within said internal chamber of said ink cartridge" as addressed hereinabove. Accordingly, in view of the foregoing, withdrawal of this rejection is respectfully requested.

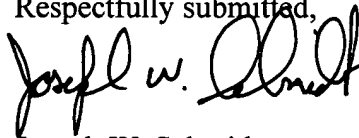
In view of the foregoing amendments and remarks, reconsideration of the rejection and objections and allowance of the claims are earnestly solicited. Accordingly, early and favorable reconsideration of this application is respectfully requested. Should the Examiner feel that a telephone or personal interview may facilitate resolution of any remaining matters, she

is respectfully requested to contact Applicant's attorney at the number indicated below.

It is respectfully submitted that none of the references of record disclose or suggest the present invention as claimed in the claims as amended, considered individually or in combination, with themselves, considered in whole or in part. Accordingly, withdrawal of the rejections and objections is respectfully requested.

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. §1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 50-2140. TWO (2) COPIES OF THIS SHEET ARE ENCLOSED

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joseph W. Schmidt", written over a horizontal line.

Joseph W. Schmidt  
Reg. No. 36,920  
Attorney for Applicant

**CARTER, DELUCA, FARRELL & SCHMIDT, LLP**  
445 Broad Hollow Road, Suite 225  
Melville, New York 11747  
(631) 501-5700  
(631) 501-3526 (fax)  
JWS/td